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U.S. Patent Application Serial No. 10/685,359
Attorney Docket No. 03-8003

REMARKS

This amendment is filed in response to the first Office Action¹ of January 25, 2008. Claims 1-44 were presented for examination and all claims were rejected.

Claims 1, 7, 10-15, 18-22, 24-25, 27-28, 30, 32-35 and 43-44 are amended.

Claims 6, 16-17, 29 and 41-42 are canceled without prejudice or disclaimer. Therefore, claims 1-5, 7-15, 18-28, 30-40 and 43-44 are pending. Claims 1, 22, 28 and 32 are in independent form.

Claims 1, 2, 4, 6-8, 15, 28, 32 and 36 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,705,995 to Laflin et al. (hereinafter “Laflin”).

Claims 1, 4, 5, 16 and 18 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,411,685 to O’Neal (hereinafter “O’Neal”).

Claims 1, 3, 9-35 and 37-44 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,937,037 to Kamel et al. (hereinafter “Kamel”).

Applicant respectfully traverses these rejections because Laflin, O’Neal and Kamel do not disclose or suggest all claim limitations of each of Applicant’s currently-amended independent claims, for the following reasons.

¹ The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any such statement. Further, silence with regard to rejection of a dependent claim, when such claim depends, directly or indirectly, from an independent claim which Applicant deems allowable for reasons provided herein, is not acquiescence to such rejection of that dependent claim, but is recognition by Applicant that such previously lodged rejection is moot based on remarks and/or amendments presented herein relative to that independent claim.

THE LAFLIN REFERENCE:

Claims 1, 2, 4, 6-8, 15, 28, 32 and 36 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Laflin. Independent claims 1, 28 and 32 have each been amended to include a limitation to “voice mail.” For example, claim 1 recites, *inter alia*, “receiving from a party at said voice mail message system, a voice mail message and a category designation for said message.” Claims 28 and 32 have similar recitations. Laflin does not disclose or suggest voice mail. Therefore, this amendment to independent claims 1, 28 and 32 has overcome this rejection, and the 35 U.S.C. § 102(b) rejection of those claims as well their respective dependent claims 2, 4, 6-8, 15 and 36 as allegedly anticipated by Laflin should be withdrawn.

THE O'NEAL REFERENCE:

Claims 1, 4, 5, 16 and 18 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by O’Neal. Claim 16 is canceled, as noted above. Independent claim 1 has been amended to include all limitations of dependent claims 16 and 17, the latter of which was not rejected as being anticipated by O’Neal. Indeed, claim 17 is rejected as being allegedly anticipated only by Kamel. Therefore, this amendment to claim 1 has overcome the 35 U.S.C. § 102(b) rejection as allegedly being anticipated by O’Neal, and the rejection of claim 1, as well as that of its pending dependent claims 4, 5, and 18 as allegedly anticipated by O’Neal should be withdrawn.

THE KAMEL REFERENCE:

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Claims 1, 3, 9-35 and 37-44 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Kamel. Applicant has amended independent claims 1, 22, 28 and 32 in a manner which overcomes this rejection. Consider, for example, claim 1 which recites:

A method of message delivery using a voice mail message system, comprising:
receiving from a party at said voice mail message system, a voice mail message and a category designation for said message;
storing said message in a storage area, said storage area accessed by said voice mail message system and corresponding to said category designation for said message;
retrieving messages from said storage area based on a user of said voice mail message system choosing said category designation;
presenting said messages to said user;
providing a first choice for said user to place a call to said party;
providing a second choice for said user to subscribe to future messages from said party when said message is presented to said user; and
identifying said future messages received at said message system from said party as subscribed to messages for said user, when said user chooses said second choice.

(claim 1, emphasis added) But, Kamel does not teach the subscribing to future messages from a “third party sponsor” (Kamel, col. 4, line 40), a party who agrees to sponsor or pay for phone calls, when a message from that sponsoring party is presented to the calling party user. Rather, Kamel teaches the subscribing to such future messages well in advance of any such message from that sponsoring party being placed on the user’s voice mail system, as explained below.

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Kamel is entitled “Communications System for Delivering Promotional Messages” and teaches a telecommunications system “for delivering promotional messages to subscribed calling parties.” (Abstract) It further states, for example: “A message bank 202 contains promotional messages to be delivered to subscribed calling parties and/or called parties.” (col. 5, lines 28-30) Note the usage of past tense for the term “subscribed” that appears in these two cites. This plainly indicates that the calling party, and possibly also the party being called by the calling party (the called party), had previously subscribed to that third party sponsor.

The limitation: “providing a second choice for said user to subscribe to future messages from said party when said message is presented to said user” appearing in currently amended claim 1 came from dependent claim 17, now canceled. The Office Action, page 7, cites Kamel, column 12, lines 4-7 as allegedly reading on this limitation in claim 17. This section of Kamel states:

“When individual end-users subscribe to the service, they will complete a ‘customer profile’ as part of the registration process which will capture relevant defining characteristics to be used for targeting purposes.” (Kamel, col. 12, lines 3-7)

This cite is referring to potential calling parties, to whom Kamel refers as “individual end users” who subscribe to a service with the third party sponsor. This cite appears in a paragraph denoted as “Message Targeting” (Kamel, col. 11, line 64) which discusses how a third party sponsor may target certain individuals or groups that such sponsor is aiming to reach with its commercial message. To find these appropriate individuals or groups, not surprisingly, a survey or questionnaire (i.e., a “customer profile”) is first forwarded to

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them, to be completed and returned to the third party sponsor before any message is played for that calling party in exchange for a free phone call. That information-gathering process is what is being referred to when the above-quoted Kamel cite says “they will complete a customer profile as part of the registration process.” Clearly, this activity of completing and returning a “customer profile” questionnaire must be undertaken prior to any messages from the sponsor being imposed on a calling party. Otherwise, the envisioned ludicrous result could be for a calling party to be startled and aggravated with an interruption by an unexpected and unwanted commercial message upon his/her attempting to place a telephone call. Without a prior agreement, a third party sponsor cannot interrupt, or delay, a telephone call between a calling party and a called party to first play a commercial message.

Accordingly, Kamel cannot read on “providing a second choice for said user to subscribe to future messages from said party when said message is presented to said user” as recited in claim 1, because any subscribing to future messages in Kamel is accomplished when the user completes the customer profile which is at a time well before when any of Kamel’s voice mail messages shall be presented to the user. Therefore, Kamel does not read on claim 1 and the 35 U.S.C. § 102(b) rejection of claim 1 as allegedly being anticipated by Kamel, as well as that of its pending dependent claims 3, 9-35 and 37-44, should be withdrawn.

Claim 22 recites, *inter alia*: “optionally subscribing to receive future messages from said party when a user of said message system retrieves one of said messages input

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by said party" which is not disclosed or suggested by Kamel for the same reasons as, or similar reasons to, those given above with respect to claim 1.

Claim 28 recites, *inter alia*: "and to present said respectively categorized messages to said user whereupon said user can optionally subscribe to receive future messages from said party" which is not disclosed or suggested by Kamel for the same reasons as, or similar reasons to, those given above with respect to claim 1.

Claim 32 recites, *inter alia*: "providing a choice for said user to subscribe to future messages from said party when executing said instructions for said presenting said messages to said user" which is not disclosed or suggested by Kamel for the same reasons as, or similar reasons to, those given above with respect to claim 1.

MPEP § 2131 states that to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ...claim." *See Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). Clearly, for reasons given above, every element of independent claims 1, 22, 28 and 32 is not found, either expressly or inherently described, in Kamel.

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Therefore, for all of the reasons given above with respect to Laflin, O'Neal and Kamel, independent claims 1, 22, 28 and 32 are allowable over these references.

Claims 2-5, 7-15 and 18-21 which are dependent directly or indirectly from claim 1 are also allowable, at least for reasons based on their respective dependencies from an allowable base claim.

Claims 23-27, which are dependent directly or indirectly from claim 22 are also allowable, at least for reasons based on their respective dependencies from an allowable base claim.

Claims 30-31, which are dependent directly or indirectly from claim 28 are also allowable, at least for reasons based on their respective dependencies from an allowable base claim.

Claims 32-40 and 43-44, which are dependent directly or indirectly from claim 32 are also allowable, at least for reasons based on their respective dependencies from an allowable base claim.

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CONCLUSION

Reconsideration and allowance are respectfully requested based on the above amendments and remarks.² If there are any remaining issues or if the Examiner believes that a telephone conversation with Applicant's attorney would be helpful in expediting the prosecution of this application, the Examiner is invited to call the undersigned. Early passage to issue is respectfully requested.

To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to deposit account number 07-2347. Please charge any other fees due, or credit any overpayment made to that account.

Respectfully submitted,

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² As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections. Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions/requirements in the future.